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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re the Application of:

TRIPP et al.

Serial No.: 09/003,574

Filed: January 6, 1998

Atty. File No.: 2618-21-1-C1

For: "NOVEL PARASITE ASTACIN
METALLOENDOPEPTIDASE
PROTEINS"

Assistant Commissioner For Patents
Box Missing Parts
Washington, D.C. 20231

Group Art Unit: 1801

Examiner:

SUBMISSION OF MISSING PARTS

CERTIFICATE OF MAILING

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS
BEING DEPOSITED WITH THE UNITED STATES POSTAL
SERVICE AS FIRST CLASS MAIL IN AN ENVELOPE
ADDRESSED TO THE ASSISTANT COMMISSIONER FOR
PATENTS, WASHINGTON, DC 20231 ON April 29, 1998.
SHERIDAN ROSE P.C.

BY: *Kathleen Bissell*

PTO

MAY 13 1998

MAIL ROOM

Dear Sir:

In response to the Notice to File Missing Parts dated April 7, 1998, in connection with the above-identified application, enclosed herewith are a Declaration and Power of Attorney. Please note that the Assignment documents have been submitted to the Assignment Branch under separate cover on this same date.

Also enclosed is a check for \$1,172 which includes payment of the filing fee in the amount of \$1,042 reflecting large entity status, and the amount of \$130.00 payment of the surcharge. Please note that the Notice inaccurately reflects the amount of independent claims over 3; therefore, the amount indicated that Applicants owe is also incorrect. Applicants' payment submitted herewith includes the extra claim which was not accounted for by the Patent Office when calculating the fees owed by Applicants. Please credit any overpayment or debit any underpayment to Deposit

Account No. 19-1970. A copy of the Notice to File Missing Parts is also enclosed.

Respectfully submitted,

SHERIDAN ROSS P.C.

By: Angela Dallas-Pedretti
Angela Dallas-Pedretti
Registration No. P-42,460
1700 Lincoln St., Suite 3500
Denver, CO 80203
(303) 863-9700

Date: 4-29-98

05/04/98
15588 U.S. PTO



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NUMBER	FILING/RECEIPT DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO./TITLE
09/003,574	01/06/98	TRIPP	2618-21-1-C1

0292/0407

SHERIDAN ROSS
GARY J CONNELL
1700 LINCOLN STREET SUITE 3500
DENVER CO 80203

NOT ASSIGNED

DATE MAILED:

04/07/98

NOTICE TO FILE MISSING PARTS OF APPLICATION
Filing Date Granted

An Application Number and Filing Date have been assigned to this application. The items indicated below, however, are missing. Applicant is given TWO MONTHS FROM THE DATE OF THIS NOTICE within which to file all required items and pay fees required below to avoid abandonment. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a). If any of items 1 or 3 through 5 are indicated as missing, the SURCHARGE set forth in 37 CFR 1.16(e) of ☐ \$65.00 for a small entity in compliance with 37 CFR 1.27, or ☒ \$130.00 for a non-small entity, must also be timely submitted in reply to this NOTICE to avoid abandonment.

If all required items on this form are filed within the period set above, the total amount owed by applicant as a

☐ small entity (statement filed) ☒ non-small entity is \$ 1070.00

☒ 1. The statutory basic filing fee is:

- ☐ missing
- ☒ insufficient

Applicant must submit \$ 790.00 to complete the basic filing fee and/or file a small entity statement claiming such status (37 CFR 1.27).

☒ 2. Additional claim fees of \$ 170.00, including any multiple dependent claim fees, are required.

[164.00] \$ 82.00 for 1 [2] independent claims over 3.
\$ 88.00 for 4 dependent claims over 20.

\$ _____ for multiple dependent claim surcharge.

Applicant must either submit the additional claim fees or cancel additional claims for which fees are due.

☒ 3. The oath or declaration:

- ☒ is missing or unexecuted.
- ☐ does not cover the newly submitted items.
- ☐ does not identify the application to which it applies.
- ☐ does not include the city and state or foreign country of applicant's residence.

An oath or declaration in compliance with 37 CFR 1.63, including residence information and identifying the application by the above Application Number and Filing Date is required.

☐ 4. The signature(s) to the oath or declaration is/are by a person other than inventor or person qualified under 37 CFR 1.42;

05/11/1998 BAILEY 00000014 09003574
A properly signed oath or declaration in compliance with 37 CFR 1.63, identifying the application by the above Application Number and Filing Date, is required.

01 FC:101
02 FC:102
03 FC:103
04 FC:105
5. The signature of the following joint inventor(s) is missing from the oath or declaration:
165.00 OP
88.00 OP
130.00 OP

An oath or declaration in compliance with 37 CFR 1.63 listing the names of all inventors and signed by the omitted inventor(s), identifying this application by the above Application Number and Filing Date, is required.

- ☒ 6. A \$50.00 processing fee is required since your check was returned without payment (37 CFR 1.21(m)).
- ☒ 7. Your filing receipt was mailed in error because your check was returned without payment.
- ☒ 8. The application does not comply with the Sequence Rules.
See attached "Notice to Comply with Sequence Rules 37 CFR 1.821-1.825"
- ☒ 9. OTHER

Direct the reply and any questions about this notice to "Attention: Box Missing Parts"

A copy of this notice MUST be returned with the reply.

Customer Service Center
Initial Patent Examination Division (703) 308-1202

PART 2 - COPY TO BE RETURNED WITH RESPONSE

37 CFR §1.56(a) and (b)
**DUTY TO DISCLOSE INFORMATION MATERIAL
TO PATENTABILITY**

(a) A patent by its very nature is affected with a public interest. The public interest is best served, and the most effective patent examination occurs when, at the time an application is being examined, the Office is aware of and evaluates the teachings of all information material to patentability. Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section. The duty to disclose information exists with respect to each pending claim until the claim is cancelled or withdrawn from consideration, or the application becomes abandoned. Information material to the patentability of a claim that is cancelled or withdrawn from consideration need not be submitted if the information is not material to the patentability of any claim remaining under consideration in the application. There is no duty to submit information which is not material to the patentability of any existing claim. The duty to disclose all information known to be material to patentability is deemed to be satisfied if all information known to be material to patentability of any claim issued in a patent was cited by the Office or submitted to the Office in the manner prescribed by §§1.97(b)-(d) and 1.98. However, no patent will be granted on an application in connection with which fraud on the Office was practiced or attempted or the duty of disclosure was violated through bad faith or intentional misconduct. The Office encourages applicants to carefully examine:

- (1) prior art cited in search reports of a foreign patent office in a counterpart application, and
- (2) the closest information over which individuals associated with the filing or prosecution of a patent application believe any pending claim patentably defines, to make sure that any material information contained therein is disclosed to the Office.

(b) Under this section, information is material to patentability when it is not cumulative to information already of record or being made of record in the application, and

- (1) It establishes, by itself or in combination with other information, a prima facie case of unpatentability of a claim; or
- (2) It refutes, or is inconsistent with, a position the applicant takes in:
 - (i) Opposing an argument of unpatentability relied on by the Office, or
 - (ii) Asserting an argument of a patentability.

A prima facie case of unpatentability is established when the information compels a conclusion that a claim is unpatentable under the preponderance of evidence, burden-of-proof standard, giving each term in the claim its broadest reasonable construction consistent with the specification, and before any consideration is given to evidence which may be submitted in an attempt to establish a contrary conclusion of patentability.*

*Note, 37 CFR §1.97(h) states: "The filing of an information disclosure statement shall not be construed to be an admission that the information cited in the statement is, or is considered to be, material to patentability as defined in §1.56(b)."